

Applic. No. 10/014,265

Amdt. dated February 16, 2005

Reply to Office action of November 16, 2004

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-39 remain in the application.

In item 3 on page 2 of the above-identified Office action, the specification has been objected to because of the following alleged informalities.

More specifically, the Examiner stated that on page 4, lines 10-12 it is unclear what is intended by "...smaller than ...by at least a factor of 0.6." The Examiner stated that the statement is not consistent with the formula in line 21.

Applicants respectfully disagree with the Examiner. The equation  $V < 0.6H$  has the exact same meaning as the sentence that "the catalytic converter has at least one honeycomb body with a total volume V smaller than the displacement H by at least a factor of 0.6." Accordingly, since the above given statement from page 4 is consistent with the formula in line 21 on page 4, it is applicants position that the statement is clear. Therefore, the specification has not been amended to overcome the objection by the Examiner.

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In item 6 on page 3 of the above-identified Office action, claims 1-39 have been rejected as being indefinite under 35 U.S.C. § 112.

More specifically, the Examiner has stated that it is unclear as to what structural limitation applicants are attempting to recite.

Applicants respectfully disagree with the Examiner. The claim language in claim 1 that "one honeycomb body with a total volume smaller than said displacement by at least a factor of 0.6" is believed to be consistent with the formula on page 4, line 21 of the specification that  $V < 0.6H$ . Furthermore, a person of skill in the art can fully understand that the volume of the honeycomb body is at least 0.6 times smaller than the displacement of the engine. Accordingly, the claim is believed to be definite. Therefore, the claims have not been amended to overcome the rejection of claims 1-39.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved.

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In item 10 on page 4 of the Office action, claims 1-2, 13-21, and 32-39 have been rejected as being obvious over Abe et al. (U.S. Patent No. 5,802,845) (hereinafter "Abe") in view of Nishimura et al. (U.S. Patent No. 6,752,969) (hereinafter "Nishimura") under 35 U.S.C. § 103.

Applicant respectfully notes that Nishimura has a United States filing date of November 22, 1999. See 35 U.S.C. § 102(e). As set forth in the Declaration of record, the instant application is a continuation application of copending International Application Serial No. PCT/EP00/03177, filed April 10, 2000, which claims international priority of the German Application No. 199 21 263.5, filed May 7, 1999, under 35 U.S.C. § 119. Pursuant to 35 U.S.C. §§ 119, 120 and 363, applicant is entitled to the priority date of the German application. See MPEP §§ 201.13 and 1895. Thus, the instant application predates Nishimura by more than 6 months. Because Nishimura was filed after the priority date of the instant application, applicant respectfully believes that Nishimura is unavailable as prior art.

Applicant acknowledges that perfection of priority can only be obtained by filing a certified English translation of the German priority application. See 35 U.S.C. § 119. Concurrent herewith, applicant has filed a Claim for Priority including

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both a certified copy of German application 199 21 263.5 and a certified English translation of same. Accordingly, applicant respectfully believes that priority has been perfected and Nishimura is unavailable as prior art. Therefore, applicant respectfully submits that the Section 103 rejection in item 10 on page 4 of the Office action is now moot.

In item 11 on page 5 of the Office action, claims 3-12, and 22-31 have been rejected as being obvious over Abe (U.S. Patent No. 5,802,845) in view of Nishimura (U.S. Patent No. 6,752,969) and further in view of Otani et al. (WO 98/51410) (hereinafter "Otani") under 35 U.S.C. § 103. As noted above, applicant believes that the Nishimura reference is not available as prior art. Therefore, the rejection is believed to be moot.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-39 are solicited.

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In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,

  
For Applicant(s)

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